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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,077	10/05/2000	Alexander S. Zharkov	9585-2	8243

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DRINKER BIDDLE & REATH  
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PHILADELPHIA, PA 19103-6996

EXAMINER

KEITH, JACK W

ART UNIT PAPER NUMBER

3641

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/680,077

Applicant(s)

ZHARKOV ET AL.

Examiner

Jack W. Keith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 16, 17, 19 and 21-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-5, 8-11, 15, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) 6, 7 and 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Invention I, species A and a in Paper No. 13 is acknowledged. The traversal is on the ground(s) that the claimed subject matter of inventions II (claim 22-25) depends on the claimed subject matter of invention I (claims 1-21). Therefore the combination/subcombination restriction/election requirement is improper.

This is not found persuasive. Claim 23 (ABbr) is an evidence claim which indicates that the combination claims 22, 24 and 25 (ABsp) do not rely upon the specific details of the subcombination claims 1-21 (Bsp) for its patentability. Accordingly, where the combination evidence claim ABbr does not set forth the details of the subcombination Bsp and the subcombination Bsp has separate utility, the inventions are distinct and the restriction is proper. See § MPEP 806.05(c) III.

Applicant further argues and request that the examiner identify the features of subcombination claim 1 not present in the combination claims 22-25. Claim 1 recites a tubular assembly having an outer surface being clad and part of said surface being bare. Bare outer surface of the tubular assembly is not present in the combination. Furthermore no igniter is present in the combination.

Applicant additionally argues that the separate utility proposed by the examiner. The examiner has shown the distinctiveness set forth in MPEP 806.05(c). That is the combination does not require the particulars of the subcombination and the

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subcombination has separate utility – i.e., a gas generator for an air bag vice a well stimulator.

Applicant argues that the classification between groups I and II is unreasonable. This is not understood. Applicant claims are directed to a well environment. How and in what manner is it unreasonable to classify and search an instrument for use in a well environment within the well art? A thorough search of all areas is provided by the office.

Applicant argues the restriction requirement between groups III and I/II/IV process of making and product made. While applicant is correct that the proposed igniter location by the examiner does not apply to claims 8-10 (group 1), 22 and 25 (group II) it does apply to the independent claims 1-7, 11-21 of the elected group. Modification of the independent claim to include such limitation would result in withdrawal of the present restriction requirement. However, a new restriction may be forth coming upon further review of the application.

Applicant argues the restriction requirement between groups IV and I/II process of making and apparatus citing the requirement as unreasonable. While such may be unreasonable to applicant the requirement set forth in MPEP 806.05(e) has been met.

The requirement is still deemed proper and is therefore made **FINAL**.

2. Claims 22-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.

3. Claims 16, 17, 19 and 21 are further withdrawn from further by the examiner consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species B (Figure 3)(claim 17) and species bi (claim 19) and bii (claims 16 and 21), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 13.

4. An action on the merits to claims 1-15, 18 and 20 follows below.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-15, 18 and 20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 8-11, 15, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Challacombe (3,721,297).

Challacombe discloses a well stimulating device capable of meeting applicant's claimed inventive concept. Referring to the figures of Challacombe a tubular assembly of solid gas generators is disclosed. Particularly a primary charge comprising a solid gas generator (52) having an outer surface and a central channel (note the central channel of the primary charge has portions that are increased in diameter in comparison

to the secondary charge (42)). The generator or tube assembly is clad on its outer surface on both of its upper (32) and lower ends (34). The rest of the surface of the generator is unclad as can be seen by the figures. An igniter (spark igniter) (72) further resides in the upper end portion of the gas generator.

Challacombe further sets forth an additional charge (42) located above the gas generator (52). The additional charge reads on claims 2-5. This additional charge having a inner clad surface (44) adhering to the surface of the charge (42). Note further that the combination of the inner clad surface (44) and cladding (32) form the claimed protective ring (claim 5) between the respective adjacent gas generators.

Additionally note cable (28) for lowering the well stimulating device of Challacombe into a well.

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

With regard to claim 18 statements of intended use, field of use, or "so constructed that " clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2d 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon (i.e., the gas generator) does not serve to limit an apparatus claim.

With regard to claim 20 it appears from the figures that the claimed ratio of bare to clad parts of the charge are met by Challacombe.

The examiner would like to further point out that the claims are open-ended (comprising). Note that comprising is open-ended and does not exclude additional, unrecited elements. See § MPEP 2111.03.

### ***Allowable Subject Matter***

8. Claims 6-7 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

9. The cited prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Keith whose telephone number is (703) 306-5752. The examiner can normally be reached on Monday-Friday 6:30-4 p.m., with First Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Jack W. Keith  
Examiner  
Art Unit 3641

November 18, 2003  
jwk